



# UNITED STATES PATENT AND TRADEMARK OFFICE

89  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,012	12/04/2001	Miki Abe	09812.0692-00000	9706
22852	7590	07/24/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CERVETTI, DAVID GARCIA	
		ART UNIT	PAPER NUMBER	
			2136	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/005,012	ABE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David G. Cervetti	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 October 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-25 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 04 December 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_ .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**DETAILED ACTION**

1. Applicant's arguments filed July 7 and October 27, 2005, have been fully considered.
2. Claims 1-25 are pending and have been examined.

***Response to Amendment***

3. The objection to the drawings is withdrawn.
4. The objection to the specification is withdrawn.
5. Regarding claim 24, Applicant's arguments are not persuasive. Contrary to Applicant's arguments, claim 24 is not substantially similar to claim 1; there is no first and second external apparatus.

***Allowable Subject Matter***

6. Claims 1-23 and 25 would be allowable.
7. The following is an examiner's statement of reasons for allowance: the prior art of record, Morito (US Patent Number: 6,782,190), does not expressly disclose "a first external apparatus which can record only encrypted content data" or "a second external apparatus which can record only decrypted content data" in combination with the other limitations recited in independent claims 1, 9, 17, and 25; claims 2-8, 10-16, and 18-23 would be allowed because of their dependence from independent claims 1, 9, and 17, respectively.
8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**9. Claims 1-23 and 25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.**

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, 17, and 25 recite the limitations "an external apparatus", "a first external apparatus", "a second external apparatus", and "said external apparatus". There is insufficient antecedent basis for these limitations in the claim.

13. Claims 1, 9, 17, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: transferring data to the first external apparatus.

***Claim Rejections - 35 USC § 102***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. **Claim 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Morito.**

**Regarding claim 24,** Morito teaches a data recording apparatus which receives encrypted content data from a data transfer apparatus having a first recording medium storing said encrypted content data and records the received encrypted content data to a second recording medium (figure 3, numerals 12 and 1), comprising:

- communication means for performing bidirectional communication with said data transfer apparatus (column 5, lines 45-55); authentication processing means for performing authentication with said data transfer apparatus through said communication means (column 5, lines 55-67, column 6, lines 1-15);
- decryption means for decrypting said encrypted content data supplied from said data transfer apparatus through said communication means (column 7, lines 55-67, column 8, lines 1-13);
- recording means for recording said content data decrypted by said description means to said second recording medium (column 5, lines 18-45); and
- control means for disabling the return of said content data from said second recording medium to said data transfer apparatus through said communication means (column 6, lines 15-27).

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

CHRISTOPHER REVAK  
PRIMARY EXAMINER

*Cl*  
7/20/06